

Remarks/Arguments:

The pending claims are 68, 70-81, 84, 93-112, and 129-133. To expedite prosecution, Applicants have canceled claims 54-67, 69, 82-83 and 113-128 without prejudice and without disclaiming their subject matter and filed corresponding claims in a continuation application on July 18, 2007. Claim 109 has been amended. Claims 129-133 have been added. No new matter is introduced therein.

Applicants sincerely thank the Examiner for the courtesies extended to their representatives during a personal interview at the PTO on June 28, 2007 to discuss the rejections of the pending claims and the cited prior art. Applicants' representatives provided the Examiner with a copy of White's specification PM 1537, filed in Australia on September 30, 1993.

As discussed during the interview, Applicants submit herewith a claim chart to assist the Examiner and enclose copies of their two priority European applications for the Examiner's convenience. The claim chart provides a non-exhaustive listing of examples of claim support found in Applicants' specification and priority documents.

I. INFORMATION DISCLOSURE STATEMENTS

Applicants submit that pages 11-12 of the IDS filed on December 5, 2005 were proper, as explained in their August 6, 2006 filing. However, to expedite prosecution, Applicants will re-submit those items in a Supplemental IDS and request the Examiner to consider them prior to mailing the next Office Action.

II. PURPORTED LACK OF PRIORITY

Paragraph 4 of the Office Action contends that Applicants have not complied with one or more conditions for receiving benefit of an earlier filing date under 35 U.S.C. §§ 119(e) and 120.

A. Purported failure to comply with 35 U.S.C. § 112, first paragraph

Paragraphs 4 and 6 of the Office Action state that the disclosures of prior-filed applications 08/463,987, 08/317,763, and 08/312,881 fail to provide adequate support or enablement in the manner provided by 35 U.S.C. § 112, first paragraph for claims 54-56, 60, 62-66, 71-84, 97, 101, 125, 126, 128. For claims 54-56, 60, 62-66, 82-83, and 113-128, this issue is moot because they have been canceled.

For claims 71-81, 84, 97, and 101, Applicants' attached claim chart demonstrates that prior-filed U.S. applications 08/312,881 (prosecution suspended); 08/317,763 (now U.S. Patent No. 5,609,627); 08/463,987 (prosecution suspended) and European applications 94400284.9;

94401306.9 provide adequate § 112, first paragraph support. The PTO's conclusion regarding claims 71-81, 84, 97, and 101 should be withdrawn along with the PTO's requirement to designate the present application as a continuation-in-part.

B. Claims are entitled to priority even if the
precise claim terms are not found in the priority application

One of the conditions for a later-filed application to receive the benefit of an earlier-filed application under 35 U.S.C. § 120 is that the prior-filed application must disclose the claimed invention of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. § 112.

The § 112, first paragraph requirements need only be met for an embodiment within the scope of the claim, and *ipsis verbis* disclosure is not required: "[I]psis verbis disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question." *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570 (Fed. Cir. 1996) (internal quotations and citation omitted) "That a claim may be broader than the specific embodiment disclosed in a specification is in itself of no moment." *Bilstad v. Wakalopoulos*, 386 F.3d 1116, 1124 (Fed. Cir. 2004)

Since Applicants have met these conditions as exemplified in the enclosed claim chart, the present application and its claims are entitled to priority of all of the prior-filed applications.

C. Inventorship of the current application need not be
the same as the inventorship in the priority U.S. applications

The bottom of page 3 of the Office Action denies priority of U.S. applications 08/463,987 and 08/317,763 and EP applications 94400284 and 94401306.9, stating that this application "was not filed by the same inventors in the prior-filed applications."

In order for a U.S. application to claim priority to a prior U.S. application, 35 U.S.C. § 120 requires only that the new application be "filed by an inventor or inventors named in the previously filed application." Section 120 does not require that all of the inventors in the new application be the same as all of the inventors of the previously filed U.S. application. Section 120 only requires that applications have a single inventor in common. The present application and the priority applications have three inventors in common: Goicoechea, Hudson, and Mialhe. Therefore, Applicants are entitled to their U.S. priority and request that the PTO acknowledged this priority.

In order for a U.S. application to claim priority to a prior European application, 35 U.S.C. § 119(a) requires only that the U.S. application be for the same invention as filed in the foreign country and be filed by a person whose legal representatives or assigns previously filed the corresponding application in the foreign country. As stated in MPEP § 201.15:

if the certified copy of the foreign application corresponds with the one identified in the oath or declaration as required by 37 CFR 1.63 and no discrepancies appear, it may be assumed that the inventors are entitled to the claim for priority. (emphasis added)

The Examiner has not identified any such discrepancies. Accordingly, Applicants request that the PTO no longer deny Applicants' priority of the two European applications.

To expeditiously move this application toward allowance, Applicants' claim chart provides specification support for the claims in the two European applications.

It is noted that the Board of Patent Appeals and Interferences and the U.S. District Court for the District of Columbia have ruled that, under the circumstances present in Interference No. 104,192, corresponding Application No. 08/461,402 is not entitled to the priority of European Application Nos. 94400284.9, filed February 9, 1994, and 94401306.9, filed June 10, 1994. Applicants have previously submitted copies of the Board and District Court decisions to the Examiner. An appeal from the District Court is currently pending in the U.S. Court of Appeals for the Federal Circuit.

III. PURPORTED LACK OF ANTECEDENT BASIS FOR CERTAIN CLAIM RECITATIONS

Paragraph 7 of the Office Action states that the specification of the present application does not provide antecedent basis for claims 54-60, 63, 71, 72, 75, 76, 79, 80, 82, 83, 97, 101, 103, 105, 111, 115, 122, 125 (this claim is not expressly identified, but its subject matter appears to be referred to on page 5, lines 19-20), 126. This issue is moot as to claims 54-60, 63, 82, 83, 115, 122, 125, and 126 because they have been canceled. The attached claim chart shows that claims 71, 72, 75, 76, 79, 80, 97, 101, 103, 105, and 111 have antecedent basis in the present application. Applicants request that the PTO withdraw this objection in view of this antecedent basis.

IV. PURPORTED INTRODUCTION OF NEW MATTER

Paragraph 8 of the Office Action states that claims 71, 75, 76, 82, 83, 101, 126 contain new matter. This issue is moot as to claims 82, 83, 126 because they have been canceled. The attached claim chart shows that claims 71, 75, 76, and 101 have antecedent support in the original specification, and Applicants request the PTO to withdraw this objection.

V. PURPORTED FAILURE TO COMPLY WITH 35 U.S.C. § 112, FIRST PARAGRAPH

Paragraphs 10-13 of the Office Action have rejected claims 71-83, 97, 101, 123, and 126 under 35 U.S.C. § 112. This rejection is moot regarding claims 82, 83, 123, 126 because they have been canceled. Since the attached claim chart shows that claims 71-83, 97, and 101 have support in the original specification, Applicants request the PTO to withdraw this rejection.

VI. PRIOR ART REJECTIONS

A. Paragraph 15 of the Office Action has rejected claims 57-58, 61, 62, 64-70, 84, 93-96, 98-100, 102, 104-121 under 35 U.S.C. § 102(e) as anticipated by Martin (U.S. Patent No. 5,575,817). Because claims 57-58, 61, 62, 64-67, 69, and 113-121 have been canceled, their rejection is moot. With respect to the remaining claims listed in this rejection, Martin is not prior art because its earliest effective filing date is August 19, 1994, whereas Applicants' European applications have filing dates of June 10, 1994 and February 9, 1994. Because this application should be entitled to the filing date of the European applications as addressed elsewhere in this response, Applicants request the PTO to withdraw this rejection of these claims.

B. Paragraph 16 of the Office Action has rejected claims 71-83 under 35 U.S.C. § 102(e) as anticipated by White (U.S. Patent No. 6,613,073). As discussed in Section IV above, the recitations in claims 71, 75, 76 are not new matter. White's earliest effective U.S. filing date is September 29, 1994. Applicants' earliest effective U.S. filing date is September 27, 1994, the filing date of U.S. Application No. 08/312,881. Applicants' claim chart demonstrates that these claims have specification support in the '881 application. Accordingly, White U.S. Patent No. 6,613,073 is not prior art against claims 71-81 (claim 82 and 83 have been canceled).

C. Paragraph 17 of the Office Action has rejected claims 122-128 under 35 U.S.C. § 102(e) as anticipated by Piplani (U.S. Patent No. 5,489,295). Paragraph 18 of the Office Action has rejected claims 57-59, 67, 68, 69, and 70 under 35 U.S.C. § 102(e) as anticipated by Chuter (U.S. Patent No. 5,387,235). Because Applicants have canceled claims 57-59, 67, 69, 122-128, these rejections are moot regarding those claims.

Claim 68 recites, in part, "...a second graft. . .adapted to be intravascularly inserted into a lumen of said first graft." Page 12 of the Office Action contends that Chuter discloses a second graft 246, 247 that is adapted to be inserted into a lumen of the first graft 206. Applicants respectfully disagree.

Grafts 246 and 247 are illustrated in Figs. 28 and 29 of Chuter, which explains that grafts 246, 247 are used as extensions of limbs 213 and 210. (col. 19, lines 15-16). The extensions 246, 247 are sutured to respective ends of limbs 213 and 210. (col. 19, lines 16-17).

Figs. 28 and 29 show that when limb 210 is stitched to limb 247, there is a space between the two limbs and that when limb 213 is stitched to limb 246, there is a space between those two limbs also. Chuter states that the stitches are eventually cut allowing the stitches to unravel and the limbs 246 and 247 to be detached when their functions have been completed. (col. 19, lines 7-18).

Accordingly, claim 68 is not subject to rejection under 35 U.S.C. § 102(e) as anticipated by Chuter.

Claim 70 recites, in part,

said first end of said supplemental graft body being dockable to said second portion of said primary graft body while inside a vessel to define a single flow lumen.

This claim is not subject to rejection over Chuter for the same reasons given regarding the rejection of claim 68. Accordingly, claim 70 is not subject to rejection under 35 U.S.C. § 102(e) as anticipated by Chuter.

Although the beginning of paragraph 18 on page 11 of the Office Action does not refer to claim 84, the end of paragraph 18 on page 12 indicates that claim 84 (dependent from claim 70) has also been rejected under 35 U.S.C. § 102(e) as anticipated by Chuter. Because claim 84 depends from claim 70, claim 84 is not subject to the same rejection at least for the same reasons that claim 70 is not subject to the rejection.

D. Paragraphs 20-22 have respectively rejected claims 54-56 and 60 under 35 U.S.C. § 103(a) as unpatentable over Martin '817 in view of Sparks (U.S. Patent No. 3,357,432); claim 63 under 35 U.S.C. § 103(a) as unpatentable over Martin '817 in view of Sparks and further in view of Marin (U.S. Patent No. 5,507,769); and claim 59 under 35 U.S.C. § 103(a) as unpatentable over Martin '817 in view of Lazarus (U.S. Patent No. 5,275,622). Since all of these claims have been canceled, these rejections are moot.

E. Paragraph 23 of the Office Action has rejected claims 97 and 101 (both dependent from claims 93 and 94) under 35 U.S.C. § 103(a) as unpatentable over Martin '817 in view of Hachtman (U.S. Patent No. 5,645,559). As previously indicated, Martin is not prior art because the European applications have earlier filing dates. In addition, Hachtman does not disclose or suggest all of the features recited in claim 93. Accordingly, Applicants request the PTO to withdraw this rejection.

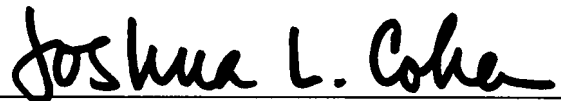
F. Paragraph 24 of the Office Action has rejected claim 103 (which depends from claim 93) under 35 U.S.C. § 103(a) as unpatentable over Martin '817 in view of Martin (U.S. Patent No. 5,653,743). Since Martin '817 is not prior art for reasons stated previously, and since Martin '743 does not disclose or suggest all of the features recited in claim 93, Applicants request the PTO to withdraw this rejection.

G. Paragraph 25 of the Office Action has rejected claims 54, 55 and 60 under 35 U.S.C. § 103(a) as unpatentable over Chuter in view of Sparks. Since these claims have been canceled, this rejection is moot.

VII. CONCLUSION

For all of the above reasons, claims 68, 70-81, 84, 93-112, and new dependent claims 129-133 are now in condition for allowance. Allowance is respectfully requested.

Respectfully submitted,



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Enclosures: Claim chart
European Application No. 94400284.9
European Application No. 94401306.9

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